



Attorney's Docket No. 028870-178

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Patent
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In re Patent Application of)
David C. Greenspan et al.) Group Art Unit: 1615
Application No.: 09/560,475) Examiner: A. E. Pulliam
Filed: April 28, 2000)
For: Anti-Inflammatory Bioactive Glass)
Particulates)

#11
51098
42402

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

In response to the Office Action mailed March 19, 2002, Applicants respectfully traverse the Restriction Requirement. According to the Office Action, Applicants must elect either Group I, drawn to a composition comprising particles of bioactive glass (claims 1-7), Group II, drawn to a method for minimizing the production of TNF-alpha (claims 8, 9, 12 and 13), Group III, drawn to a method for increasing IL-6 levels in a patient (claims 10, 14 and 15) or Group IV, drawn to a composition comprising particles (claim 11).

Moreover, the Examiner requires election of a single disclosed species from the following: intramuscular administration, intraperitoneal administration and intravenous administration.

Applicants respectfully traverse the requirement as improper at this point in the prosecution of the application. According to MPEP 811, an examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops. Claims directed to the subject matter of each group now subject to restriction have been present in the application since the filing date, but were not previously subject to restriction. These claims have been rejected in a substantive office action, which was responded to by Applicants. The restriction

Serial No. 09/164,293

requirement states that the election by Applicants is necessary because the inventions are distinct and have acquired a separate status in the art. However, at least one search apparently has already been conducted on all of the claims in view of the office action already issued in this case on the merits.

Moreover, in light of Applicants' response filed December 20, 2001, the claims are in condition for allowance, and should not be divided at this late date. In view of the timing of the restriction requirement, Applicants respectfully request that the requirement be withdrawn and prosecution on all the claims be allowed to continue.

In the alternative, if a restriction requirement is deemed appropriate over Applicants' traversal, at least Groups I and IV, respectively, and Groups II and III, respectively, should be examined together in light of the subject matter of the claims included in those groups. For example, the subclasses to be searched for the claims in Groups I and IV are overlapping and a search for all of the claims in these groups could be conducted without undue burden on the examiner. As noted in MPEP § 803, if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

As to Groups II and III, the methods claimed are methods which should be examined together. For example, the specification states that the compositions and methods of the invention can suppress plasma concentrations of tissue necrosis factor-alpha while increasing plasma concentrations of interleukin-6. *Page 5, lines 21-23*. The relationship between the claimed methods is discussed in the application. *See, for example, pages 5-7 and 15-16*. Thus, if the restriction requirement is not withdrawn in its entirety, at least the claims of Groups II and III should be examined together.

In complete response to the restriction requirement, Applicants elect the claims of Group II, claims 8, 9, 12 and 13, for prosecution in the above-identified application with traverse.

Serial No. 09/164,293

Applicants further have been required to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. In complete response to the election of species requirement, Applicants elect intraperitoneal administration for prosecution in the above-identified application with traverse. Applicants submit that at least claims 1, 3 and 11 include the elected species and claims 1, 3-7, 9-12 and 14 are generic claims.

Pursuant to the request in the Office Action, enclosed is a copy of the Information Disclosure Statement filed January 19, 2001, and supporting documents.

Applicants reserve the right to file a divisional application covering the subject matter of the non-elected claims.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By Mary B. Grant
Mary B. Grant
Registration No. 32,176

P.O. Box 1404
Alexandria, Virginia 22313-1404
(919) 941-9240

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